

REMARKS

As an initial point, Applicant would like to point out that claims 35-68, which were added in the response to the first requirement, correspond to claims 1-34, rewritten in a more traditional American style. These claims are not intended to greatly expand the scope of the claims as assumed by the Office in this case. Applicant encourages the Office to review the claim set to compare these two claim sets, both of which are directed to a method for producing effervescent granules that involves a multi-step process where the reaction is carried out in a chamber with vacuum pressure changes performed without an intermediate drying step. This multi-step process is the special technical feature of all claims in the application because all of the manufacture method claims are dependent, directly or indirectly, from either claim 1 or claim 35, which essentially are equivalents written in different language. Applicant reiterates the arguments presented concerning prior art in the previous response and incorporates this response herein in its entirety.

As in the first requirement, Applicant elects Group I, with traverse. This group is characterized by the Office as drawn to a method of making effervescent granules. At least claims 1-17, 22-31, 35-51 and 57-66 all are directed to such a method and encompass the invention defined as Group I by the Office.

In the telephonic interview held January 22, 2010, the Examiner indicated that the Groups for restriction were defined based on the groupings of dependent claims, i.e. by number, rather than by the actual language or content of the claims, since the examiner did not recognize the groups of dependent claims as having any "antecedent basis" in the main claim. The dependent claims therefore were considered unrelated to the base claim and consequently directed to separate and completely different inventions.

Applicant was asked to explain how each group of dependent claims was related to the base claim in terms of "antecedent basis" such that it could be understandable

how and why the subject matter of the dependent claims was the same invention as that of the main claim. Applicant will go through the dependent claims by Group as separated by the Office.

Applicant would like to remind the Office that all dependent claims specify a further limitation to the subject matter of the referenced claim and therefore need not and can not have explicit "antecedent basis" for all elements of the dependent claim. Therefore, it is not proper to restrict a claim merely because it is a dependent claim and adds a feature to the invention. Dependent claims are construed to incorporate by reference all the limitations of the claim to which it refers. 35 U.S.C. § 112, fourth paragraph. They therefore have a basis in the referenced claim.

Group II is defined by the Office as drawn to a method of claims 1 and 35 "wherein the reaction is stopped one of two maxima is reached [sic]." This group contains claims 1, 6-9, 27, 35, 40-43 and 61. As noted by the examiner, all these claims depend from claim 1 or claim 35. Claims 7-9, 27, 41-43 and 61 all depend from claim 6 or its rewritten version, claim 40. Claims 6 and 40 each relate to the method which is performed by choosing in advance either a maximum number of repeating cycles (i.e., step (d) of claim 35) or a maximum duration of the reaction and performing the "stopping" step, (i.e., step (e) of claim 35) when that pre-selected stopping point of the reaction before performing an identical reaction as recited in the independent claim does not result in a new invention. Therefore, all of these claims relate to an optional feature of the base claim.

Group III is defined by the Office as drawn to a method of claims 1 and 35 wherein a granulating liquid is added to at least one of or the mixture of the reactive constituents. This group contains claims 1, 11, 23, 29, 35, 45, 57 and 63, which like the claims of Group II, all depend from the base claims 1 and 35. These claims all relate to the exact method recited in claim 1 and its essential equivalent claim 35, but adding the new feature of further adding a granulating liquid to one or both of the effervescent components before or during evacuation (i.e., step (b) of claim 35) in claim 45, prior to

evacuation, in claim 57, or by aspiration, in claim 63. The methods of the dependent claims therefore are based on the method of the independent claim. Specifying that a granulating liquid is added with the other loaded components when performing the identical method of the base claim does not change the invention here or result in an invention distinct from the invention of claims 1 and 35.

Group IV is defined by the Office as drawn to a method of claims 1 and 35 where the dried granules are mixed with a pharmaceutical active substance. This group contains claims 1, 14, 15, 30, 35, 48, 49 and 64, which, as the Office has acknowledged, all depend from claim 1 or its essential equivalent, claim 35. These claims contain all limitations present in the base claim(s) and add a new step of mixing the granules produced in the method with a pharmaceutical active substance or an excipient. This further step does not change the method or the character of the invention to result in a distinct invention since the same multi-step process is used in all cases.

Group V is defined by the Office as drawn to a method of claims 1 and 35 where carbon dioxide is passed in during the reaction cycles. This group contains claims 1, 16, 22, 35, 50 and 56, which all contain the limitations of base claim 1 or 35. These claims relate to a method (claims 1, 16, 35 and 50) or a granule (claims 22 and 56). The claims clearly refer to the reaction cycles of the method of claim 1 or the steps c)-d) of claims 35 and therefore directly relate to the method of those claims while adding an additional step of passing in carbon dioxide during the reaction. Other than the new feature recited in the dependent claims, the method is identical. Therefore, the dependent claims have a basis in the independent claims.

Group VI is defined by the Office as drawn to a method of claims 1 and 35 where the dried granules are treated with carbon dioxide, optionally with stirring. This group contains claims 1, 17, 31, 35, 51 and 65, which also contain all the limitations of their base claim(s). The addition of this feature to the method of the base claim does not change the method so as to alter the character of the invention and clearly is an

optional step that is part of the same method. These claims also have a basis in the main claim from which they depend.

None of the optional or additional features discussed above are related to a different method of producing an effervescent granule or change the claimed method to such an extent that it becomes a separate invention, and all claims clearly relate to the method of claim 1 and claim 35. The invention of claims 1 and 35 and any of the dependent claims discussed above do not have a separate status in the art. Further, the Office has not established that they have different classifications or divergent subject matter. All the claims relate to the same multi-step method with the same special technical feature. This special technical feature is the multi-step process involving repeated vacuum/reaction processes without intermediate drying step(s) using a "pendulum" vacuum. This process is not described in or suggested by the art and would have to be searched for any of the currently restricted claim groups.

Applicant submits that it is improper to require division of the application merely because dependent claims are recited to claim particular embodiments of the same invention. Applicant submits that the method claimed in all the claims is both novel and nonobvious, and that the special technical feature (the multi-step process discussed above) that unites the claims is novel and nonobvious. All of claims 1-17, 22-32, 35-51 and 57-66 must be examined together.

Applicant requests reconsideration of the requirement and examination of claims 1-17, 22-32, 35-51 and 57-66 at this time.

Respectfully submitted,

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